

REMARKS/ARGUMENTS

In the Restriction Requirement dated June 29, 2007 the Examiner delineated the following inventions as being patentably distinct:

Group I: Claims 1-9, drawn to a water-based intermediate coating composition;

Group II: Claims 10-12, drawn to a method for forming a multilayer coating film; and

Group II: Claim 13, drawn to a multilayer coating film.

Applicants provisionally elect with traverse the invention of Group I (Claims 1-9) drawn to a water-based intermediate coating composition.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction.

The claims of Group I are integrally linked with the claims of Groups II and III. The claims of Groups I, II and III are related as composition, method of making, and method of use. There is a technical relationship that involves the same feature, and it is this technical feature that defines the contribution which each of the Groups, taken as a whole make over the prior art.

The Office has failed to consider that there is a common significant element shared by all the claims and that is the water-based intermediate composition of a copolymer resin emulsion and a curing agent. The Examiner has failed to supply any references or specific examples to support the allegation that other methods can be used to make the final product.

Final product, method of making, and the use thereof are interdependent and should be examined together on the merits, especially wherein the sole disclosed utility of the product is that recited in the specification.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim and is in the same category of claims as the other claims. It does not matter if a dependent claim itself contains a further invention.

Further, the M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate or as an alternative within a single claim.

For the reasons set forth above, Applicants request that the Restriction Requirement be withdrawn.

Applicants further request that if the invention of Group I is found allowable, withdrawn Groups II and II which includes all the limitations of the allowable claims be rejoined.

Respectfully submitted,

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